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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,919	03/10/2004	Jeffrey Lewis Brandt	1033-LB1049	3346
60533 7590 03/26/2008 TOLER LAW GROUP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759				
EXAMINER				
FRANKLIN, JAMARA ALZAIDA				
ART UNIT		PAPER NUMBER		
2876				
MAIL DATE		DELIVERY MODE		
03/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,919

Applicant(s)

BRANDT ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 29, 2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 11, and 22, and therefore dependent claims 2-10, 12-21, and 23-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In response to the newly amended independent claims including the limitation citing "...and the attempted transaction is approved without providing the notification message when the attempted transaction does not satisfy the threshold-based rule" and in response to the assertion that the Brown invention and other prior art cited in the rejections above do not teach

the new limitation, the examiner contends that no support for the aforementioned limitation is found, particularly in paragraph 32 and 33 of the specifications where threshold-based rules are discussed.

The newly added limitation seems to be most similar to the example in paragraph 33 which discloses the pre-approval of a large expenditure amount over a threshold he/she had set. If the aforementioned passage is indeed the passage from which the newly added limitation is drawn, it is suggested that language in support of this pre-approval of a large expenditure amount over a threshold he/she had set be included in the newly amended claims.

For examination purposes, the examiner will interpret the newly added limitations to reflect an approval of a transaction without providing a notification message when the attempted transaction does not exceed a predetermine purchasing limit.

Appropriate correction or clarification is required

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 6, 9-12, 16, 19, 20, and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (US 2003/0144952) (hereinafter referred to as 'Brown') in view of Ramsey-Catan (US 2003/0069802).

Brown teaches a method comprising:

providing a notification message to a payment card holder of an attempted transaction using a payment card when the attempted transaction satisfies a threshold-based rule (the determination of the comparison of an inputted PIN) to allow the notification message to be provided (paragraph 37);

wherein the notification message includes a plurality of options for the payment card holder to decline authorization of the attempted transaction (paragraph 37);

the method wherein the plurality of options comprise a first option for the payment card holder to decline authorization of an undesirable but non-fraudulent transaction (steps 332 and 334), and a second option for the payment card holder to decline authorization of a fraudulent transaction (steps 332, 336, 338, 340, and 342) (paragraph 37);

the method further comprising:

receiving a selection made by the payment card holder of the second option (paragraph 37); and

based on the selection, automatically reporting the fraudulent transaction to a law enforcement authority (paragraphs 37 and 45);

the method wherein the notification message indicates a transaction amount, a merchant name, and at least part of a number of the payment card (paragraph 37);

a system comprising:

a payment card transaction notification and authorization system configured to provide a notification message to a payment card holder of an attempted transaction using a payment card, to provide a first option for the payment card holder to decline authorization of the attempted transaction, to provide a second option for the payment card holder to decline authorization of the attempted transaction, and to decline authorization of the attempted transaction in response to receiving information indication an input selecting the first option or the second option by the payment card holder;

the system wherein a first option relates to declining authorization of an undesirable but non-fraudulent transaction, and the second option relates to declining authorization of a fraudulent transaction;

the system wherein the payment card transaction notification and authorization system is further configured to automatically report the fraudulent transaction to a law enforcement authority in response to receiving information indicating an input selecting the second option by the payment card holder; and

the method and system wherein the payment card transaction notification and authorization system is further configured to provided an option for the payment card holder to authorize the transaction (steps 325 and 326).

Brown lacks the teaching of approving the attempted transaction without providing the notification message.

Ramsey-Catan teaches an attempted transaction approved without providing a notification message when the attempted transaction does not satisfy a threshold-based rule.

One of ordinary skill in the art would have readily recognized that providing the Brown invention with the approval of an attempted transaction without providing a notification message would have been beneficial for lessening the number of steps required to complete a transaction process, thereby making the transaction process a quicker one to accommodate fast-paced lifestyles. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Brown with the aforementioned teaching of Ramsey-Catan.

7. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Walker et al. (US 5,999,596) (hereinafter referred to as 'Walker').

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of returning the payment card to an individual attempting the transaction.

Walker teaches a method and system of returning a payment card to an individual attempting a transaction (col. 10, lines 45-54).

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with the step of returning the payment card to an individual attempting the transaction would have been beneficial for a case in which the individual

attempting the transaction is a child of a cardholder. Returning the card to the child would then be expected and necessary in circumstances where the child has not stolen the card from the parent so that the child may use the card in the future. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Brown/Ramsey-Catan with the aforementioned teaching of Walker.

8. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Slater et al. (US 4,114,027) (hereinafter referred to as 'Slater').

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of withholding the payment card from an individual attempting the transaction.

Slater teaches a method and system wherein a payment card is withheld from an individual attempting a transaction (col. 12, lines 50-63).

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with the withholding of the payment card would have been beneficial for ensuring that the card is no longer active within a business environment thereby protecting vendors and merchandise against future fraud. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Brown/Ramsey-Catan with the aforementioned teaching of Slater.

9. Claims 5, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Gopinathan et al. (US 5,819,226) (hereinafter referred to as 'Gopinathan').

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of locking an account.

Gopinathan teaches a method and system comprising locking an account (col. 4, lines 3-7).

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with the locking of an account would have been beneficial for ensuring the account may not be manipulated in a manner that would financially hurt an actual cardholder in the event that the actual cardholder is unaware of the fraud. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Brown/Ramsey-Catan with the aforementioned teaching of Gopinathan.

10. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Cheechio (US 6,052,675).

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of automatically reporting the fraudulent transaction to a credit reporting agency (col. 1, lines 26-30); and

Cheechio teaches a method and system of automatically reporting a fraudulent transaction to a credit reporting agency (col. 1, lines 26-30).

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with the method of reporting the fraudulent transaction would have been beneficial for allowing a record to be kept of the fraud and thereby possibly enabling the faculty to take action toward the security of the actual cardholder. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings Brown/Ramsey-Catan with the aforementioned teaching of Cheechio.

11. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Taylor (US 2003/0182214).

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of a reason code.

Taylor teaches a method and system of sending a reason code involved in an attempted transaction (paragraph 44).

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with a reason code would have been beneficial for ensuring that the exact reason for the decline is indicated, thereby allowing the merchant react accordingly for the best interest of the card holder. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Brown/Ramsey-Catan with the aforementioned teaching of Taylor.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown/Ramsey-Catan in view of Tubinis (US 2003/0014367).

The teachings of Brown/Ramsey-Catan have been discussed above.

Brown/Ramsey-Catan lack the teaching of a short messaging service.

Tubinis teaches a system wherein a purchase limit is increased based on a short message service (SMS) received from a payment card holder.

One of ordinary skill in the art would have readily recognized that providing the Brown/Ramsey-Catan invention with a short messaging service for increasing a purchasing limit would have been beneficial for ensuring that a purchasing limit is adequate enough for a purchase so as to prevent the cardholder from not being able to attain a desired product or service. Therefore, it would have been obvious at the time the invention was made, to modify the teachings of Brown/Ramsey-Catan with the aforementioned teaching of Tubinis.

Response to Arguments

13. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection which were prompted by the amending of the independent claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

JAF
March 20, 2008